



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/644,218

08/19/2003

David Blankley

P/131-1

6467

⁷⁵⁹⁰
Philip M. Weiss, Esq.
Weiss & Weiss
Suite 251
300 Old Country Road
Mineola, NY 11501

12/17/2007

EXAMINER

COPPOLA, JACOB C

ART UNIT

PAPER NUMBER

4143

MAIL DATE

DELIVERY MODE

12/17/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/644,218	Applicant(s) BLANKLEY, DAVID	
	Examiner Jacob C. Coppola	Art Unit 4143	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

1. This action is in reply to the application filed on 19 August 2003.
2. Claims 1-24 are currently pending and have been examined.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 11-24 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The system of Claim 11, and all dependent claims thereof, are directed to a network-based system. "System" is commonly used to denote a machine. Here, the claim is not directed to a machine, but rather to a program or code. Network-based applications, programs and code are not statutory subject matter. Alternatively, processes and "computer-executable programs tangibly embodied on a computer readable medium" may be considered statutory subject matter under 35 U.S.C. 101.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 8 recites the limitation "said royalties" in line 2. There is insufficient antecedent basis for this limitation in the claim.
7. Claim 15 recites the limitation "said derivative work" in line 2. There is insufficient antecedent basis for this limitation in the claim.
8. Claim 16 recites the limitation "said derivative work" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. Claims 1-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stefik et al. (U.S. 5,629,980 A) (hereinafter Stefik '980), in view of Stefik et al. (U.S. 2005/0138056 A1) (hereinafter Stefik '056).
12. **Examiner's Note:** The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

As per Claim 1

Stefik '980, as shown, discloses the limitations:

- *connecting an author* ("the owner of a digital work") *to a content repository; sending data from said author to said content repository* ("A repository is comprised of..., an external interface for receiving and transmitting data"), (see at least column 3, lines 51-61 and column 4, lines 6-13; see also Figure 1 and associated text);
- *sending content from said author to said content repository* ("A repository is comprised of a storage means for storing a digital work..., an external interface for receiving and transmitting data"), (see at least column 4, lines 6-13; see also Figure 1 and associated text);
- *connecting a collaborator to said content repository* ("Here a Repository 2 initiates a session with Repository 1, step 103"), (see at least column 7, lines 6-37; see also Figure 1 and associated text);

- *downloading said content from said author to said collaborator from said content repository* ("Repository 2 may then request access to the Digital Work for a stated purpose, step 104... If access is granted, repository 1 transmits the digital work to repository 2, step 107"), (see at least column 7, lines 6-37; see also Figure 1 and associated text);
- *connecting a final uploader to said content repository*; ("the requester sends the server a message to initiate an Edit transaction"), (see at least column 40, lines 60-67)
- *uploading aggregate content and meta data from said final uploader to said content repository* ("the requester uses the process to change the contents of the digital work as desired... combine it with other information... taking whatever other steps are useful in creating a derivative work"), (see at least column 41, lines 7-13).

Stefik '980, as shown, does not disclose *final uploader* and *uploading aggregate content and meta data from said final uploader*, as recited in the final two limitations of the claim. Stefik '980, however, in at least column 35, lines 1-29 and in at least column 40, lines 47-67 and column 41, lines 1-39 discloses, "Transfer Transactions" and "Edit Transactions" that would allow the requester to act as the claimed *final uploader* and to edit the content in Repository 2 (now acting as the server), creating a "derivative work" or *aggregate content* and transfer it back to Repository 1 (here Repository 1 and Repository 2 are the same as cited above from Figure 1 and associated text).

Stefik '980, as shown, does not specifically disclose *meta data* as claimed above in the first limitation. Stefik '056, however, in at least paragraph [0073] discloses, "Document dimensions are derived from document content, meta-data (such as author, publisher, publication date, etc.), as well as any other data which identifies, or otherwise categorizes, a document". Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to substitute or include the "meta-data" that identifies a document, disclosed by Stefik '056, with the "data" that is being transferred between repositories disclosed by Stefik '980. One

would have been motivated to do so because in the field of information retrieval, for example, documents are retrieved in many ways, including but not limited to, matching of meta-data such as authors and publication dates (see at least paragraph [0008]).

As per Claim 2

Stefik '980/Stefik '056 discloses the limitations of claim 1, as described above.

Stefik '980, as shown, further discloses the limitations:

- *determining content contributors ("creator") and royalty allocations ("associated fees")*, (see at least column 6, lines 51-56).

As per Claim 3

Stefik '980/Stefik '056 discloses the limitations of claim 1, as described above.

Stefik '980, as shown, further discloses the limitations:

- *notifying all contributors regarding use of said content* ("the server generates a transaction identifier that is used in records or reports of the transaction"), (see at least column 31, lines 5-37).

As per Claim 4

Stefik '980/Stefik '056 discloses the limitations of claim 1, as described above.

Stefik '980, as shown, further discloses the limitations:

- *tracking what content a user accesses* ("the display/execution repository 411 is further coupled to a credit server 414 to report any fees to be billed for access to a digital work"), (see at least column 8, lines 57-67 and column 9, lines 1-5).

As per Claim 5

Stefik '980/Stefik '056 discloses the limitations of claim 1, as described above.

Stefik '980, as shown, further discloses the limitations:

- *collecting subscription fees for said author from a user* (“credit server 301 communicates to the billing clearinghouse 303 via clearinghouse transactions”) *and logging activity of said user to determine royalty allocation* (“accumulates billing information”), (see at least column8, lines 10-21).

As per Claim 6

Stefik '980/Stefik '056 discloses the limitations of claim 2, as described above.

Stefik '980, as shown, further discloses the limitations:

- *billing all users on a periodic basis based on use* (“the billing module may... periodically communicate billing data to a central billing facility, whereupon the user may be billed”), (see at least column 3, lines 1-12).

As per Claim 7

Stefik '980/Stefik '056 discloses the limitations of claim 2, as described above.

Stefik '980, as shown, further discloses the limitations:

- *determining periodically royalties owed to each author and disbursing funds* (“the billing module may... periodically communicate billing data to a central billing facility, whereupon the user may be billed”), (see at least column 3, lines 1-12).

As per Claim 8

Stefik '980/Stefik '056 discloses the limitations of claim 2, as described above.

Stefik '980, as shown, further discloses the limitations:

- *calculating said royalties based on usage of each authors works* (“usage rights and any associated fees assigned by a creator”), (see at least column 6, lines 51-56).

As per Claim 9

Stefik '980/Stefik '056 discloses the limitations of claim 2, as described above.

Stefik '980, as shown, further discloses the limitations:

- *determining an algorithm to allocate royalties* (“data structure, such as a look-up table, wherein the various information associated with a right is maintained... usage rights and any associated fees assigned by a creator”), (see at least column 9, lines 50-67 and column 10, lines 1-7; and column 6, lines 51-56).

As per Claim 10

Stefik '980/Stefik '056 discloses the limitations of claim 9, as described above.

Stefik '980, as shown, further discloses the limitations:

- *wherein said algorithm varies based on type of content being sold* (“Grammar Element 1517... provides a range of options for billing for the use of digital works”), (see at least column, lines).

As per Claims 11 and 12

Stefik '980, as shown, discloses the limitations:

- *a data base which allows an author to upload content* (“A repository is comprised of..., an external interface for receiving and transmitting data”), (see at least column 3, lines 51-61 and column 4, lines 6-13; see also Figure 1 and associated text);
- *said system organizing said content* (“A repository is comprised of a storage means”), (see at least column 4, lines 6-13).

Stefik '980, as shown, does not disclose the “storage means” as *organizing said content by author, title of content, description of content or reuse methodology*. Furthermore, Stefik '980 does not disclose *information to contact said author*. Stefik '056, however, in at least paragraph [0073] discloses, “Document dimensions are derived from document content, meta-data (such as author, publisher, publication date, etc.), as well as any other data which identifies, or otherwise categorizes, a document”. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to include the “meta-data” that identifies a document and its author, disclosed by Stefik '056, with the “storage means” disclosed by Stefik '980. One would

have been motivated to do so because in the field of information retrieval, for example, documents are retrieved in many ways, including but not limited to, matching of meta-data such as authors and publication dates (see at least paragraph [0008]).

As per Claim 13

Stefik '980/Stefik '056 discloses the limitations of claim 11, as described above.

Stefik '980, as shown, further discloses the limitations:

- *wherein said reuse methodology describes how content can be used and fees entailed* (“usage rights and any associated fees”), (see at least column 6, lines 51-56).

As per Claim 14

Stefik '980/Stefik '056 discloses the limitations of claim 13, as described above.

Stefik '980, as shown, further discloses the limitations:

- *wherein said fee is selected from a flat fee, royalty from direct user, royalty from final end work creator or combination thereof* (“associated fees”), (see at least column 6, lines 51-56).

As per Claim 15

Stefik '980/Stefik '056 discloses the limitations of claim 14, as described above.

Stefik '980, as shown, further discloses the limitations:

- *wherein a user can aggregate works from different authors, view said aggregate work and integrate said work to create said derivative work* (“the requester uses the process to change the contents of the digital work as desired... combine it with other information... taking whatever other steps are useful in creating a derivative work”), (see at least column 41, lines 7-13) .

As per Claim 16

Stefik '980/Stefik '056 discloses the limitations of claim 15, as described above.

Stefik '980, in at least column 7, lines 38-56 discloses, "repository 201 is general in the sense that it's primary purpose is as an exchange medium for digital works". This repository feature in conjunction with the multiple repository transactions that Stefik '980's disclosed system is capable of performing on accessed digital works (see at least "Transfer Transaction" and "Edit Transaction" in at least column 35, lines 1-29 and column 40, lines 47-67; and in at least column 41, lines 1-39) teaches the limitation: *derivative work is put into said system which can be used as a further derivative work.*

As per Claim 17

Stefik '980/Stefik '056 discloses the limitations of claim 11, as described above.

Stefik '980, as shown, further discloses the limitations:

- *wherein said system provides logical rules on how to use said content* ("when a user requests access to a digital work, the repository will initiate various transactions"), (see at least column 26, lines 38-47).

As per Claim 18

Stefik '980/Stefik '056 discloses the limitations of claim 11, as described above.

Stefik '980, as shown, further discloses the limitations:

- *wherein said system provides said author rules to use for said content and said author chooses said rules and sends said rules back to said system* ("the combination of transactions invoked will depend on the specifications assigned for a usage right"), (see at least column 26, lines 38-47).

As per Claim 19

Stefik '980/Stefik '056 discloses the limitations of claim 18, as described above.

Stefik '980, as shown, further discloses the limitations:

- *wherein said rules includes fees* ("Financial Transactions"), (see at least column 26, lines 38-47).

As per Claim 20

Stefik '980/Stefik '056 discloses the limitations of claim 11, as described above.

Stefik '980, as shown, further discloses the limitations:

- *determining content contributors* ("creator") *and royalty allocations* ("associated fees"), (see at least column 6, lines 51-56).

As per Claim 21

Stefik '980/Stefik '056 discloses the limitations of claim 11, as described above.

Stefik '980, as shown, further discloses the limitations:

- *wherein said system informs said authors* ("the server generates a transaction identifier that is used in records or reports of the transaction"), (see at least column 31, lines 5-37).

As per Claim 22

Stefik '980/Stefik '056 discloses the limitations of claim 11, as described above.

Stefik '980, as shown, further discloses the limitations:

- *wherein said system logs activity of users and determines royalty allocation for said authors* ("accumulates billing information"), (see at least column 8, lines 10-21).

As per Claim 23

Stefik '980/Stefik '056 discloses the limitations of claim 11, as described above.

Stefik '980, as shown, further discloses the limitations:

Art Unit: 4143

- *wherein said system bills users periodically* (“the billing module may... periodically communicate billing data to a central billing facility, whereupon the user may be billed”), (see at least column 3, lines 1-12).

As per Claim 24

Stefik '980/Stefik '056 discloses the limitations of claim 11, as described above.

Stefik '980, as shown, does not explicitly disclose *wherein said system checks for duplicate content, if duplicate content is found said system does not post said duplicate content*. Stefik '980, however, in at least column 13, lines 59-67 discloses, “Identification certificates are encrypted to prevent forgery and are issued by a Master repository”. Examiner interprets forgery to be defined as “an imitation that is passed off as genuine” (see at least Merriam-Webster). Therefore, Stefik '980 discloses a system that prevents imitations or counterfeit *duplicate content* (regarding Identification certificates) to be issued or *posted* by a Master repository.

Conclusion

Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **Jacob C. Coppola** whose telephone number is **571.270.3922**. The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **JAMES A. REAGAN** can be reached at **571.272.6710**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair> <<http://pair-direct.uspto.gov> >. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C., 20231

or faxed to **571-273-8300**.

Hand delivered responses should be brought to the **United States Patent and Trademark Office Customer Service Window:**

Randolph Building

401 Dulany Street

Alexandria, VA 22314.

/Jacob C Coppola/ Examiner, Art Unit 4143

November 16, 2007

/James A. Reagan/Supervisory Patent Examiner, Art Unit 3621